

APPELLANTS' BRIEF ON APPEAL

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellants: Norishige Morimoto, et al.

Examiner: Arthur D. Duran

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DISTRIBUTION, REGISTRATION,
MANAGEMENT, AND REPRODUCTION

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Commissioner for Patents
P.O. Box 1450
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APPEAL BRIEF

Sir:

Pursuant to 35 USC § 134 and 37 CFR §41.37, entry of Appellants' Appeal Brief, provided in support of Appellants' Notice of Appeal dated January 2, 2008, is respectfully requested.

The Appeal Brief sets forth the authorities and arguments upon which Appellants rely in support of their Appeal from the final rejection of all of pending claims 3-5, 24 and 31, over the asserted prior art, where the final rejection was set forth in a final Office Action mailed November 2, 2007. Claims 1, 2, 6-23, 25-30, 32 and 33 have been previously withdrawn from consideration.

CERTIFICATE OF ELECTRONIC FILING

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Dated: February 21, 2008



John F. Vodopia, Esq.

I. REAL PARTY IN INTEREST

The real party in interest of the present application is International Business Machines Corporation, the assignee of the entire right, title and interest in the above-identified patent application.

II. RELATED APPEALS AND INTERFERENCES

No other appeals or interferences are known which directly affect, or will be directly affected by, or have a bearing on, the disposition of the pending appeal.

III. STATUS OF THE CLAIMS

The claims argued on appeal are claims 3-5, 24 and 31. The status of pending claims 3-5, 24 and 31, on appeal is as follows:

Claims 3-5, 24 and 31 were rejected under 35 USC §102(b) as unpatentable over US Patent No. 5,848,396 to Gerace (Gerace).

IV. STATUS OF AMENDMENTS

In response a first final Office Action mailed July 20, 2007, in the pending application, Appellants filed an Amendment Under 37 CFR 1.116, on September 20, 2007 ("the after final Amendment"). An Advisory Action was mailed from the Patent Office on October 3, 2007 ("the Advisory Action"), which maintained the final rejection of claims 3-5, 24 and 31.

On October 22, 2007, appellants filed a request for continued examination (RCE) and Amendment Under 37 CFR 1.114, in an attempt to again persuade the Examiner of the patentability of the finally rejected claims, which final rejection was maintained by the Advisory Action. A second final Office Action issued on November 2, 2007, that maintained the final rejection of claims 3-5, 24 and 31 under 35 USC §102(b) over US Patent No. 5,848,396 to Gerace (Gerace). In response to the second final Office Action, appellants filed their Notice of Appeal on January 2, 2008.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Claims 1-33 are included in the application, where claims 1, 2, 6-23, 25-30, 32 and 33 are withdrawn, and claims 3-5, 24 and 31 are pending on appeal. Pending claim 3 is the sole independent claim. Claims 4, 5, 24 and 31 depend from claim 3.

A copy of claims 1-33, including the finally rejected claims pending on appeal, is attached hereto in the Claims Appendix. Independent claim 3 is presented (in this Section V.) with reference to support for the various independent claim features that are found in appellants' Specification, and related drawing figures. The support is provided parenthetically.

The invention of independent claim 3 as claimed sets forth a content registration/management system (See Summary of the Invention, page 4, line 10-page 5, line 24) comprising:

content registration request reception means, for receiving a request for content registration from a content provider that provides content (Figs. 1 and 2, content registration request reception unit 21);

identifier provision means, for setting an identifier, based on said request that is received, to be added to said content that is to be provided a user terminal, and for providing said identifier to the content provider (Figs. 1, 2; registration/ledger preparation unit 13); and

a content ledger database, for storing information related to said identifier provided said content provider (Figs. 1, 2; content ledger database 11).

The patentability of the dependent claims shall stand or fall based on the patentability of sole independent claim 3.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 3-5, 24 and 31 were finally rejected under 35 USC 102(b) over US Patent No. 5,848,396 to Gerace, by the final Office Action (dated November 2, 2007). Appellants

believe that the rejection is improper because Gerace does not teach each of the elements of independent claim 3, nor the subject matter of claim 3 as a whole.

VII. ARGUMENT

A.) Gerace does not anticipate claims 3-5, 24 and 31 under 35 USC §102(b)

In the final Office Action of November 2, 2007, the rejection of claims 3-5, 24 and 31 under 35 USC 102(b) over Gerace was maintained (on final). Appellants submit that the final rejection of claims 3-5, 24 and 31 under 35 USC §102(b) in view of Gerace is improper in that Gerace does not disclose Appellants' invention as claimed.

With respect to independent claim 3, the Examiner asserts that Gerace discloses a content registration/management system comprising:

content registration request reception means, for receiving a request for content registration from a content provider that provides content (Figs. 5a-5d; col. 3, lines 4-20);

identifier provision means, for setting an identifier, based on said request that is received, to be added to said content that is to be provided a user terminal, and for providing said identifier to a content provider (col. 17, line 52-col. 18, line 10; col. 6, line 57-col. 7, line 23);
and

a content ledger database, for storing information related to said identifier provided said content provider (col. 33, line 35-col. 34, line 27).

Appellants' invention as claimed comprises a content registration/management system whereby content providers, such as owners of rights to a popular musical composition, allow their content to be downloaded to users for free, but the content owner is compensated by advertisers who have an advertising identifier inserted with the content that is downloaded. The user gets the free content, with the inserted identifier (i.e., advertisement), wherefore the advertiser pays the content owner the equivalent of a royalty that it might normally be entitled to from the user by the "free use" (for example, what the content owner might be accorded from the user under ASCAP rules).

Appellants' inventive content registration management system (such as set forth in independent claim 3) allows the advertiser to choose which content (freely downloadable content) he/she wishes to include its advertising identifier in. The content with the advertisement identifier could then be downloaded to the content-user for free, but the content-owner still gets paid by the advertiser. There is no need for preparing profiles, or conducting the other elements of the Gerace techniques, for targeting particular user groups based on psychological or user-use profiling, itself based on tracked user computer activity or viewing habits. For example, where the free downloadable content is music, an advertiser using the inventive system only need decide if he/she wants their advertising identifier downloaded with, for example, a U2 recording (a content) or a Celine Dion recording (another content), to direct such advertising to groups who prefer U2 to Celine Dion, or vice versa.

Appellants independent claim 3 recites one embodiment of the invention as a content registration/management system. The claimed system provides that an advertiser makes content registration requests via content registration request reception means, in order to choose which content that it wishes to incorporate it's advertising identifier. The first element of appellants' claim 3 content registration/management system specifically calls out: "content registration request reception means, for receiving a request for content registration from a content provider that provides content." The content registration management system further includes an element defined as an identifier provision means that sets the identifier (advertising identifier) that will be included with the content as identified by the advertiser's request.

The second element of appellants' claim 3 content registration management system calls out: identifier provision means, for setting an identifier, based on said request that is received, to be added to said content that is to be provided a user terminal, and for providing said identifier to a content provider. The claim 3 content registration management system further stores information relating to the identifier provided by the content provider. Hence, the last element called out by appellants' content registration management system i: a content ledger database, for storing information related to said identifier provided by said content provider.

Appellants understand that Gerace is readily distinguishable from such claimed content registration management system under section 102. Significantly, the Court of Appeals for the Federal Circuit emphasizes that a strict identity test must be met in order for a reference to anticipate a claim under 35 U.S.C. 102. For instance, in Apple Computer, Inc. v. Articulate Systems, Inc., 57 USPQ2d 1057, 1061 (Fed. Cir 2000), the Court explained that: “[a]nticipation under 35 U.S.C. 102 requires the disclosure in a single piece of prior art of each and every limitation of a claimed invention.” “Substantial identity” or “equivalency” is not sufficient. RCA Corp. V. Applied Digital Data Sys., Inc., 221 USPQ 385 (Fed. Cir. 1984).

Appellants find that Gerace teaches targeted marketing by the use of agate information in order to determine a behavioral or psychographic profile of a computer user. The Gerace targeted marketing system and method, by its use of the behavioral or psychological profile, is distinguished from both appellants’ invention as claimed and known demographic profiling by providing (i) a data assembly for displaying customized agate information to a computer user, and (ii) a tracking and profiling member for recording user activity with respect to agate information displayed through the data assembly. Gerace’s tracking and profiling member, over time, holds a history and/or pattern of user activity, which in turn is interpreted as the member’ habits and/or preferences for the advertising purposes. To that end, a psychographic profile is inferred from the recorded activities in the tracking and profiling member. The tracking and profiling member records presentation (format) preferences of the user based on their viewing activity.

Preferences with respect to color schemes, text size, shapes, and the like are recorded as part of the psychographic profile of a user. In turn, the psychographic profile enables the data assembly to customize presentation (format) of agate information, per user, for display to the user. The data assembly displays the agate information and/or advertisements combined in a common screen view or separately in respective screen views, which advertisements are stored in an advertisement module and displayed to users in accordance with the psychographic profile of the user. The tracking and profiling member also records demographics of each user, whereby the data assembly is able to transmit advertisements for

display to users based on psychographic and demographic profiles of the user to provide targeted marketing.

Gerace does not disclose or even suggest a content registration/management system including content registration request reception means, for receiving a request for content registration from a content provider that provides content, identifier provision means, for setting an identifier, based on said request that is received, to be added to said content that is to be provided a user terminal, and for providing said identifier to a content provider and a content ledger database, for storing information related to said identifier provided said content provider.

For that matter, while the Examiner then asserts that Gerace discloses a content registration/management system at Figs. 5a-5d, and at col. 3, lines 4-20, including content registration request reception means, for receiving a request for content registration from a content provider that provides content, appellants just do not find the support at the cited text as asserted. Gerace's Figs. 5a-5b illustrate a set of sponsor objects 33a, ad package objects 33b, ad series objects 33c and ad objects 33d. Nowhere do Figs. 5a-5d show or even suggest appellants' element comprising content registration request reception means, for receiving a request for content registration from a content provider that provides content. More, the text at col. 3, lines 4-20 describes how Gerace's sponsor object categorizes advertisements or other sponsor provided info according to content and presentation, and how sponsor and user objects track how many times each piece of advertisement information is shown to, is selected by and/or spawns a purchase by users. Appellants' claimed content registration request reception means is intended for receiving a request for content registration from a content provider that provides content, and is not disclosed or even implied by the Gerace text at col. 3.

And while the Examiner asserts that Gerace's text at col. 17, line 52-col. 18, line 10, and at col. 6, line 57-col. 7, line 23, discloses applicant's claimed identifier provision means, for setting an identifier, based on said request that is received, to be added to said content that is to be provided a user terminal, and for providing said identifier to a content provider, appellants again respectfully disagrees. Gerace's text at col. 17, line 52-col. 18, line 10, merely discloses

that portion of the Gerace technique that includes sponsor log-on for browsing the agate information and advertisements for the end user, including entering demographic targets, completion of the advertiser template, and discusses how the Gerace program combine the regression analysis with their weighting technique for automatic optimization (as defined by Gerace). Gerace at col. 6, line 57-col. 7, line 23, discloses its user account history object, action history object, user session object, etc. Nowhere within the cited Gerace text is found appellants' identifier provision means, for setting an identifier, based on said request that is received, to be added to said content that is to be provided a user terminal, and for providing said identifier to a content provider.

While the Examiner asserts that Gerace at col. 33, line 35-col. 34, line 27, discloses appellants' claimed content ledger database, for storing information related to said identifier provided said content provider, appellants again respectfully disagree. Gerace's Appendix IV provides a list of advertising reporting features, detailed package reports, demographic response rates, psychographic profiling, mapping, regression demographics and customer reports, no part of which can, with all due respect, can be considered the same or the equivalent of appellants' claimed content ledger database, for storing information related to said identifier provided said content provider.

Appellants, therefore, respectfully assert that Gerace does not disclose, teach or suggest each of the elements of independent claim 3, as required under 35 USC §102(b), and request that the Board of Patent Appeals and Interferences overturn the rejection of independent claim 3 under Section 102(b) in view of Gerace. Because claims 4, 5, 24 and 31 depend from independent claim 3, these claims are patentable with claim 3. The other references of record have been reviewed, and these other references, whether considered individually or in combination, also do not disclose or suggest this feature of the present invention.

B.) Conclusion

Appellants, therefore, respectfully assert that independent claim 3, and claims 4, 5, 24 and 31 that depend from claim 3, are not anticipated by Gerace under section 102(b), and urge

the Board to overturn the final rejection of claims 3-5, 24 and 31 under Section 102(b) in view of Gerace, and allow these pending claims.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'John F. Vodopia', is written over the typed name.

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Enclosures: Appendices VIII, IX and X

VIII. CLAIMS APPENDIX

1. (Withdrawn) An advertisement distribution system comprising:

a content provider system, for providing for a user terminal a content to which an identifier has been added;

a user terminal, for receiving said content, via a network, from said content provider system, and for identifying and outputting, to said network, said identifier added to said content; and

an advertisement provider system, for the distribution to said user terminal, based on said identifier output by said user terminal, of a predetermined advertisement via said network.

2. (Withdrawn) The advertisement distribution system according to claim 1, further comprising:

an agent server system, for managing said identifier added to said content,

wherein said agent server system employs said identifier, output by said user terminal, to transmit an advertisement distribution trigger to said advertisement provider system for the distribution of said predetermined advertisement.

3. (Previously Presented) A content registration/management system comprising:

content registration request reception means, for receiving a request for content registration from a content provider that provides content;

identifier provision means, for setting an identifier, based on said request that is received, to be added to said content that is to be provided a user terminal, and for providing said identifier to the content provider; and

a content ledger database, for storing information related to said identifier provided said content provider.

4. (Original) The content registration/management system according to claim 3, further comprising:

identifier reception means, for receiving from a user terminal an identifier provided for said user terminal; and

content reproduction information collection means, for collecting, based on the reception of said identifier, information related to the reproduction of content.

5. (Original) The content registration/management system according to claim 4, further comprising:

an advertisement ledger database for registering a list of contents that can be used as advertisement media; and

notification means for searching said advertisement ledger database based on said received identifier, and for transmitting an advertisement distribution request to an advertiser.

6. (Withdrawn) An advertisement distribution management system, which is connected to a user terminal connected to a network and which manages the distribution of an advertisement to a user terminal, comprising:

an advertisement ledger database, for the storage therein of a list to which content used as an advertisement medium and information concerning an advertisement distribution site for disseminating said advertisement when said content is reproduced;

reception means, for receiving a content IS output by said user terminal when said content is reproduced;

search means, for performing a search, based on said content ID, of said advertisement ledger database for said predetermined advertisement distribution site; and

notification means, for issuing to said advertisement distribution site, when found, an advertisement distribution request.

7. (Withdrawn) The advertisement distribution/management system according to claim 6, wherein said reception means receives address information for said user terminal, and said notification means transmits the address information to said advertisement distribution site.

8. (Withdrawn) A content provider system, which is connected to a user terminal via a network and which provides a content for said user terminal, comprising:

storage means, for storing pertinent content and a corresponding content ID for identifying said pertinent content;

reception means, for receiving a content download request from said user terminal; and

content provision means, for reading, based on said content downloading request, said pertinent content and said corresponding content ID from said storage means, and for providing for said user terminal said pertinent content and said content ID.

9. (Withdrawn) The content provider system according to claim 8, wherein said storage means is used to store a content with a content ID being embedded.
10. (Withdrawn) The content provider system according to claim 8, further comprising:
registration request output means, for outputting a registration request to an agent server that manages a content ID; and
content ID reception means, for receiving, based on said registration request, said content ID from said agent server.
11. (Withdrawn) A user terminal comprising:
content reproduction means, for reproducing content wherein a content ID has been embedded;
detection means, for detecting said embedded content ID when said content is to be reproduced;
notification means, for transmitting said detected content ID to a predetermined server via a network; and
additional information reception means for receiving from a predetermined additional information distribution site, via a network, additional information corresponding to said content ID.
12. (Withdrawn) The user terminal according to claim 11, wherein, before reproduction of said content, said content reproduction means outputs said additional information received by said additional information reception means.

13. (Withdrawn) The user terminal according to claim 11, further comprising:
- content search means, for searching, via a network, for preferred content in a predetermined server; and
- downloading means, for downloading, as a search result obtained by said content search means, content in which said content ID is embedded.
14. (Withdrawn) An advertisement distributor system comprising:
- registration request output means, for outputting an advertisement registration request to an agent server system that manages an identifier included in predetermined content;
- address information reception means, for receiving address information for a user terminal that reproduces content; and
- advertisement data distribution means, for distributing advertisement data that is output to said user terminal for content reproduction.
15. (Withdrawn) The advertisement distributor system according to claim 14, further comprising:
- bill reception means, for receiving from said agent server system a bill corresponding to the frequency whereat content is reproduced; and
- advertisement fee payment means, for paying an advertisement fee in accordance with said bill.

16. (Withdrawn) A content reproduction program that permits a computer, for reproduction of content in which a content ID is embedded, to perform:

- a function for detecting said content ID embedded in said content;
- a function for transmitting said content ID via a network; and
- a function for, before content reproduction, outputting advertisement data, based on said content ID, that has been received via said network.

17. (Withdrawn) The content reproduction program according to claim 16, wherein said function for outputting said advertisement data that is received displays an advertisement, interacting with reproduction of said content.

18. (Withdrawn) A storage medium on which a computer stores a computer-readable program that permits said computer to perform:

- a process for, before content reproduction, detecting said content ID embedded in said content;
- a process for transmitting said content ID via a network; and
- a process for outputting additional information, based on said content ID, that are received via a network, while interacting with said content reproduction.

19. (Withdrawn) An additional information distribution method comprising the steps of:
providing an identifier for digital content to identify said digital content;
detecting said identifier before reproduction of said digital content to which said identifier is added;

transmitting said detected identifier, together with user terminal information, to a network; and

distributing predetermined additional information to said user terminal based on said identifier that is transmitted.

20. (Withdrawn) The additional information distribution method according to claim 19, wherein said predetermined additional information to be distributed is an advertisement that corresponds to said digital content.

21. (Withdrawn) The additional information distribution method according to claim 20, further comprising the steps of:

counting said identifiers transmitted to said network; and

charging an advertisement distributor in accordance with the number of advertisements that are distributed.

22. (Withdrawn) A content distribution system comprising:

a content provider system, for providing for a user terminal a content to which an identifier has been added;

a user terminal, for receiving said content, via a network, from said content provider system, and for identifying and outputting, to said network, said identifier added to said content; and

an content provider system, for the distribution to said user terminal, based on said identifier output by said user terminal, of predetermined content via said network.

23. (Withdrawn) A method comprising steps to implement the functions of the content distribution system of claim 22.
24. (Original) A method comprising steps to implement the functions of the content registration/management system of claim 3.
25. (Withdrawn) A method comprising steps to implement the functions of the advertisement distribution management system of claim 6.
26. (Withdrawn) A method comprising steps to implement the functions of the content provider system of claim 8.
27. (Withdrawn) A method comprising steps to implement the functions of the user terminal of claim 11.
28. (Withdrawn) A method comprising steps to implement the functions of the advertisement distributor system of claim 14.
29. (Withdrawn) An article of manufacture comprising a computer usable medium having computer readable program code means embodied therein for causing content distribution, the computer readable program code means in said article of manufacture comprising computer readable program code means for causing a computer to effect the steps of claim 23.

30. (Withdrawn) A computer program product comprising a computer usable medium having computer readable program code means embodied therein for causing advertisement distribution, the computer readable program code means in said computer program product comprising computer readable program code means for causing a computer to effect the functions of claim 1.

31. (Original) A computer program product comprising a computer usable medium having computer readable program code means embodied therein for causing content registration/management, the computer readable program code means in said computer program product comprising computer readable program code means for causing a computer to effect the functions of claim 3.

32. (Withdrawn) A computer program product comprising a computer usable medium having computer readable program code means embodied therein for causing content provision, the computer readable program code means in said computer program product comprising computer readable program code means for causing a computer to effect the functions of claim 8.

33. (Withdrawn) A computer program product comprising a computer usable medium having computer readable program code means embodied therein for causing content advertisement distribution, the computer readable program code means in said computer program product comprising computer readable program code means for causing a computer to effect the functions of claim 14.

IX. EVIDENCE APPENDIX

None. There is no evidence presented.

X. RELATED PROCEEDINGS APPENDIX

None. There are no related proceedings.